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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,359	02/05/2004	John C. Hill	511-007	8409

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The Halvorson Law Firm PC  
405 W Southern Ave  
Suite 1  
Tempe, AZ 85282

EXAMINER

HOWARD, SHARON LEE

ART UNIT PAPER NUMBER

1615

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/774,359	<b>Applicant(s)</b> HILL ET AL.	
	<b>Examiner</b> Sharon L. Howard	<b>Art Unit</b> 1615	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-15 and 17-31 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-6,8-15,17-31 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***The examiner acknowledges receipt of the amendment and the remarks filed on 10/22/04. The rejection over claims 25,28-31 has been considered withdrawn. Claim 7 has been cancelled. Claims 1-6,8-15, and 17-31 are pending.***

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6,8,9 remain rejected under 35 U.S.C. 102(b) as being anticipated by Kaplan (U.S. Patent No. 5,047,232).

The reference teaches non-aqueous waterproof oil-based compositions which are used as vehicles for sunscreen compositions, and a method of preparing the said compositions (see col.1, lines 7-14). Kaplan teaches jojoba oil, lanolin oil, coconut oil, olive oil, liquid lanolin and cottonseed oil which are suitable cosmetic emollients (see col.3, lines 49-54). Kaplan teaches semi-solid cosmetic emollients include hydrogenated lanolin, petrolatum, isopropyl lanolate, butyl myristate, cetyl myristate, cetyl alcohol and isocetyl lanolate (see col.4, lines 12-20). The compositions may also contain dyes which can be defined as colorants, perfumes and antioxidants (see col.5, lines 22-24). Although Kaplan is silent with respect to the teaching of the temperature range, the teaching of the particular range is inherent and encompassed therein. Kaplan teaches a semi-solid emollient composition.

The Kaplan reference meets the claims of the instant application.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6,8,9 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan ('232).

The Kaplan reference is applied above.

The reference does not teach the particular temperature.

However, absent a showing in the criticality of the particular temperature, there are no unexpected results. The prior art reference teaches the same product, a semi-solid emollient composition known in cosmetics.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6,8,9-31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Arquette (U.S. Patent No. 5,968,530) in view of Miller (U.S. Patent No. 4,286,609).

Arquette teaches an emollient composition which is used in cosmetic products. Arquette teaches that the cosmetic products can be produced from fatty alcohols, isopropyl esters and wax esters, which can be obtained from jojoba oil. Arquette teaches jojoba wax esters (see col.4, lines 40-62). Arquette teaches that the emollient compositions may be used as emollient carriers (see col.7, lines 46-60). Arquette teaches fragrances, pigments, antimicrobial agents, antibacterial materials, pheromones, anti-inflammatory agents, sun blocks and sunscreens and insect repellants which may be combined with the emollient carrier (col.7, lines 46-60). Arquette discloses a process for making an emollient comprising the steps of a) providing a composition comprising jojoba oil, b) adding an alcohol to the said composition, c) effecting alcoholysis on said jojoba oil mixed with said alcohol to produce an emollient, and d) effecting interesterification of remaining wax esters (see col.8, lines 49-67, bridging col.9, lines 26).

Arquette does not specifically teach a container that retains the semi-solid emollient.

However, Miller teaches a hot oil fingernail and cuticle treatment which is known in the art for moisturizing the tissues surrounding the nail (see col.1, lines 21-35). Miller discloses using a bottle containing the inventive mixture which is used as a hot oil treatment. Miller also teaches that the treatment involves using a cuticle stick which is cylindrical in shape (see col.2, lines 3-23). Miller teaches that the hot oil treatment uses a concentration of animal and vegetable oils, proteins, vitamins and other ingredients. The animal and vegetable oils include corn, olive, cottonseed, sesame and coconut oils

(see col.2, lines 24-37). Miller discloses a method for treating a cuticle using the emollients (see col.4, lines 32-63).

As for the teaching of extending the emollient composition past an opening in the container or extruding the emollient composition past the opening in the container, and replacing the cap on the container, one of ordinary skill in the art would know the suitable means to perform this function.

Both references teach emollient compositions comprising oils and other ingredients. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. See *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). One having ordinary skill in the art would have been motivated to modify the composition of Arquette to include a container that retains the emollient composition, because the third composition can be used for the same purpose of softening or moisturizing the cuticle and the tissues surrounding the nails.

### ***Response to Arguments***

Applicant's arguments filed 10/22/04 have been fully considered but they are not persuasive. Applicant argues that the Kaplan emollient composition is clearly not semi-solid since it is intended as a vehicle for sunscreens. As such, the sunscreen vehicle would need to be liquid in order to be dispensed and dispersed on the dermis of the user. A semi-solid emollient composition, in a sunscreen application, would likely irritate the

Art Unit: 1615

dermis and provide incomplete coverage. There is no teaching or suggestion in Kaplan that a transport vehicle for sunscreens, a protector of the dermal layers of the skin, would be useful for conditioning and protecting cuticles, which are solid protein layers. Clearly the Kaplan reference does not disclose a device that is substantially identical to the claimed invention. Kaplan discloses an emollient composition that is a transport vehicle for sunscreen compositions and the present invention discloses an emollient composition for treating cuticles. Further, there is no teaching or suggestion in Kaplan to make the Kaplan emollient composition semi-solid, as in the present invention. Thus, since Kaplan has been distinguished above, and since Kaplan's silence as to the claimed temperature range has no bearing on the reasons for the applicant's temperature range and does not support the examiners claim that the range is obvious, Kaplan and its silence as to temperature do not render claims 1-6 and 8-9 obvious. Arquette does not teach or disclose is an emollient composition for cuticle treatment. There is no teaching or suggestion in Arquette to provide an emollient composition for treating cuticles, let alone a semi-soft composition. There is no teaching or suggestion in Miller to cool the treating oils, in deed, Miller requires heating by the inclusion of hot water with the oil mixture.

In response to applicant's arguments, absent of recitation of the viscosity of the term "semi-solid", the term "semi-solid" does not distinguish over the emollient composition. The claims are directed to a semi-solid emollient composition "for cuticle treatment" which is for future-intended use which does not aid in defining in the composition over the prior art and the secondary reference (Miller '609) suggest the

Art Unit: 1615

teaching of the process of treating a cuticle. In conclusion, the prior art renders the claims obvious and the rejection set forth above is maintained for reasons of record.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

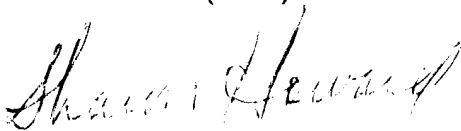
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Howard whose telephone number is (571) 272-0596. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sharon Howard  
November 27, 2004



THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600